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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/696,295   | 10/28/2003  | Lawrence Morrisroe   | 694231/0051 JJD:IGD | 5110             |
| 7590   | 06/16/2005  |                      | EXAMINER            |                  |
| James J. DeCarlo<br>Stroock & Stroock & Lavan LLP<br>180 Maiden Lane<br>New York, NY 10038 |             |                      | MYHRE, JAMES W      |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3622                |                  |

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/696,295             | MORRISROE ET AL     |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | James W. Myhre         | 3622                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 04 February 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-29 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-29 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment filed on February 4, 2005 is sufficient to overcome the Inoue (US 2003/0208560) reference. The amendment added new Claim 29 and amended Claims 1, 11, 16, and 24. The currently pending claims considered below are Claims 1-29.

### ***Claim Rejections - 35 USC § 101***

2. The amendment filed on February 4, 2005 added references to technology in the independent claims and are now considered to be directed to statutory matter. Therefore, the Examiner withdraws the rejection of Claims 1-6, 11-14, 16, 22, 23, 25, and 26 in paragraph 2 of the August 18, 2004 Office Action.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly et al (5,740,549).

Claims 1, 11, 12, 16, 24, 25, and 29: Reilly discloses a method for providing an advertisement over a network comprising:

- a. Identifying a plurality of files, including one with at least one placeholder (insertion point) therein (col 5, line 47 – col 6, line 10 and col 8, lines 50-53);
- b. Combining an advertisement file with a conduit (tracking) file to create an integrated advertisement file containing the advertisement content and the tracking data (col 5, line 47 – col 6, line 10 and col 8, lines 50-53);
- c. Serving (transmitting) the integrated advertisement file to a client computer (e.g. consumer's computer)(col 5, line 47 – col 6, line 10).

While Reilly does not explicitly disclose that the advertisement file and the tracking file are combined during the transmission to the client computer, the cited passage discloses that the transmission will include a plurality of objects, such as information items, advertisements, display statistics, update data, upgrade data, etc. It is well known to combine such objects into a batch file for transmission over a network. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the conduit file with the advertisement file to which it pertained. One would have been motivated to combine these files in this manner in order to enable the client computer to more easily identify the correlation between the files and in order to facilitate the batch transmissions discussed by Reilly.

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Claims 2, 3, 13, 14, 22, 23, and 28: Reilly discloses a method for providing an advertisement over a network as in Claims 1, 12, 16, and 25 above, and further discloses receiving modified advertisement and conduit files and updating the client computer to reflect the updated information (col 5, line 47 – col 6, line 10 and col 8, lines 24-31).

Claims 4 and 26: Reilly discloses a method for providing an advertisement over a network as in Claims 1 and 25 above, but does not explicitly disclose the file type or programming language in which the advertisement is written. However, such decisions of file type and programming language are management decisions based on such factors as the capability of the system hardware and the capability and familiarity of the computer programmer with files types and programming languages. Since Flash ads and .swf files were both known prior to the filing date of this application, they would have been among the obvious choices for the system designer from which to choose when setting up the system.

Claims 5, 6, 15, 17, and 27: Reilly discloses a method for providing an advertisement over a network as in Claims 1, 11, 16, and 26 above, and further discloses that the advertisement file can include an animated sprite generator used to simulate motion (i.e. movie clip object). While it is not explicitly disclosed that the conduit file will be inserted into this empty movie clip object, the Examiner notes that since the conduit file contains tracking data (according to Claim 1), not a movie clip,

once the conduit file is inserted into an appropriate area (object) within the advertisement file, such as the claims empty movie clip object, that area is no longer an empty movie clip object but is the conduit file object. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to insert the conduit file into any appropriate "empty" space or object within the advertisement file. One would have been motivated to use the empty movie clip object in view of the fact that it was empty space which was not being used for anything else in the claimed invention.

Claims 7-9, 18, and 19: Reilly discloses a method for providing an advertisement over a network as in Claims 1 and 16 above, and further discloses linking to one or more webpages (displayed either in the same window or in another window) when the user clicks on a button, the advertisement, or any other linking object on the screen (col 13, lines 3-25). The Examiner notes that html codes, URLs, JavaScript files, and links are normal parts of webpages and links and are suggested by Reilly's disclosure of the World Wide Web. A more detailed description of the Internet, the World Wide Web, HTML, URLs, web pages, and links can be found in the Background of the Invention section (columns 1-3) of the Levergood et al (5,708,780) reference listed in the Conclusion section below.

Claim 10: Reilly discloses a method for providing an advertisement over a network as in Claim 1, and further discloses including a tracking identifier for tracking the advertisement (col 9, lines 18-33 and col 11, lines 64-66).

Claims 20 and 21: Reilly discloses a method for providing an advertisement over a network as in Claim 16 above, and further discloses using a web-based executable program (application) to perform the steps of the invention (col 4, lines 23-38).

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1-28 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. McAuliffe et al (5,838,790) discloses a method for presenting an advertisement over a network which combines tracking data with the advertisement, downloads the combined file to the client computer and uses buttons and links on the advertisement to connect the user to other webpages when the link is activated.

b. Levergood et al (5,708,780) discloses a method for presenting an advertisement over a network which discusses in detail various parts and features of the World Wide Web, such as HTML coding, links, URL's, webpages, etc. Also disclosed is

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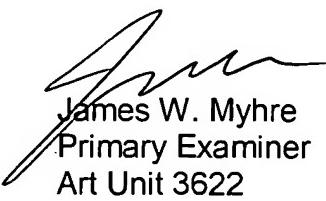
a method for monitoring (tracking) the frequency and duration of access to webpages containing advertisements.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (571) 272-6722. The examiner can normally be reached Monday through Thursday from 5:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (571) 272-6724. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9306. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (571) 273-6722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-3600.

  
JWM  
June 13, 2005

  
James W. Myhre  
Primary Examiner  
Art Unit 3622